

REMARKS

Original claims 33-54 are presently pending. Claims 1-32 have been canceled. As the only amendments to the claims are the cancellation of claim 1-32, these amendments do not require further search or consideration and should be entered.

Rejections under 35 U.S.C. § 103

Independent claims 33 and 34 stand rejected under §103(a) as being unpatentable over the combination of U.S. Patent 6,449,344 to Goldfinger et al. ("Goldfinger") and U.S. Patent 6,389,127 to Vardi et al. ("Vardi"). Dependent claims 35-54 stand rejected under §103(a) as being unpatentable over various combinations of Goldfinger, Vardi, and U.S. Patent No. 5,848,134 to Sekiguchi et al. ("Sekiguchi"). Applicant respectfully traverses these rejections, and reconsideration of Applicant's pending claims is respectfully requested.

Hypothetical Combination does not Achieve Claimed Subject Matter.

As the PTO provides in MPEP §2143, "[t]o establish a prima facie case of obviousness, . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP §2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

Claim 33 recites in part, "identifying a subscriber, a telephone number at which they can receive messages, and a period of time for which they can receive messages at this number..." Neither Goldfinger nor Vardi, alone or in combination, teach or suggest identifying a period of time for which they can receive messages at a number or establishing the user's presence and ability to receive instant messages on the data network during the specified time period, as is recited in claim 33. The Office action relies on Goldfinger at col. 6, lines 35-51 when addressing this element. However, the

cited text of Goldfinger recites:

a user 34 establishing a connection to communications network 14 preferably in the same manner as described for user 18 in FIG. 1. Once user 34 is connected, information management apparatus 28 checks the list of sought users to determine if user 34 is sought by user 18. If so, information management apparatus 28 then checks the list of connected users to determine if user 18 is still connected. If user 18 is still connected, information management apparatus 28 causes annunciator 24 to transmit an annunciation to user 18, wherein the annunciation typically includes the unique identification code for sought user 34, the current network address for sought user 34, and preferably other information provided by user 18. Information management apparatus 28 preferably also checks the list of sought users to determine if user 18 is sought by user 34 and, if so, causes annunciator 24 to transmit an annunciation to user 34 as described above.

(Emphasis added.)

The Office Action of October 24, 2003, on page 12, states that, "[t]he Examiner interprets the fact that the information management checks to see the appropriate time to send the message as a period of time for which the user can receive a message." Applicant respectfully submits that this statement is not supported by the cited references. To elaborate further, the Goldfinger patent requires "check[ing] the list of connected users to determine if user 18 is still connected..." as opposed to claim 33 which provides for, "identifying ... a period of time for which they can receive messages at this number." In other words, Goldfinger discloses checking whether the user is actually connected, while the method of claim 33 assumes that the user is connected during the period of time. Therefore, the hypothetical combination of the cited references fails to achieve Applicant's claimed invention.

Accordingly, the combined art fails to meet the standard presented by MPEP § 2143, which requires that the cited references must teach or suggest all the claim

limitations to establish a prima facie case of obviousness. Therefore, claim 33 is allowable for at least this reason. Claim 34 recites similar limitations and is therefore allowable, as are claims 35-54, which depend from and further limit claim 34.

Conclusion

It is respectfully submitted that independent claims 33 and 34 are in condition for allowance. Dependent claims 35-54 depend from and further limit claim 34 and therefore are allowable as well.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 23, 2003.

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